

Remarks

Claims 1-77 are pending in the Application. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Applicants Provisionally Elect With Traverse

In response to the Action requiring species election, Applicants, as the requirement is best understood, provisionally elect with traverse the alleged Species VIII. The alleged Species VIII is alleged by the Office to be directed to "a personal automated transaction machine where the processor is operative responsive to the first service proxy to cause the service to perform a transaction function responsive to the account information". The alleged Species VIII was also alleged by the Office to correspond to original claims 44-56 (now claims 44-66). As the requirement is best understood, all claims 1-77 are readable on the alleged Species VIII.

Reconsideration and withdrawal of the election requirement are respectfully requested. Applicants respectfully submit that the requirement is not legally proper and should be withdrawn.

The Action does not meet the requirements necessary for election requirement

MPEP § 1893.03(d) states that "When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group".

The Applicants respectfully submit that the Office Action does not meet these requirements. Nowhere in the Action does the Office explain why each asserted group lacks unity with each other group. The Action does not compare any group with any other group. It follows that the Action does not compare each group with each other group. The eleven (11)

alleged groups would require numerous separate comparisons. Yet Applicants have not received even one comparison. Thus, the Action does not meet the burden of requirement (2), which is necessary to sustain the species election requirement. Since an explanation has not been provided, the Action also does not comply with the procedural rules of the Office. Thus, the species election requirement is defective and should be withdrawn.

Furthermore, nowhere in the Action does the Office specifically describe "the unique special technical feature in each group." The Action fails to specifically describe the unique special technical feature in each group, which is also necessary to sustain the species election requirement. The Action also does not describe how each asserted group has a unique special technical feature which is not found in each other group. Again, the Action lacks any comparison whatsoever of the eleven groups. It follows that the Action lacks the required comparison of each individual group with each other individual group.

The Action must explain why each group lacks unity with each other group. This would require separate comparisons for each of I/II, I/III, I/IV, I/V, I/VI, I/VII, I/VIII, I/IX, I/X, I/XI; II/III, II/IV, II/V, II/VI, II/VII, II/VIII, II/IX, II/X, II/XI; III/IV, III/V, III/VI, III/VII, III/VIII, III/IX, III/X, III/XI; IV/V, IV/VI . . . IV/X, IV/XI; V/VI, V/VII . . . V/X, V/XI; VI/VII . . . VI/X, VI/XI; VII/VIII . . . VII/XI; VIII/IX, VIII/X, VIII/XI; IX/X, IX/XI, and X/XI. The Action lacks the required comparisons. The Action has not shown why there is no single general inventive concept. The Action has not shown that the alleged species are prevented from being used in the same embodiment. Nor has the Action met the general test for mutually exclusive species. It follows that the Action has not met its burden for a proper species restriction requirement.

The Requirement is not legally proper because there is no serious burden

MPEP § 803 sets forth criteria for a proper election requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for election to be required.

Contrarily, if the search and examination of an entire application can be made without serious burden then the examiner must examine it on the merits. Applicants respectfully submit that the election requirement is not legally proper because the criteria for serious burden has not been met.

The Requirement is not legally proper as a reasonable number of species are permitted

Applicants are entitled to a reasonable number of species (i.e., a plurality of species). Even if it were somehow possible for the Office to show serious burden (which it hasn't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Applicants respectfully submit that even if the application had species as alleged by the Office, the alleged species would still be reasonable, especially in light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

**The Requirement is not legally proper
because a valid reason for species restriction is absent**

The "mutually exclusive characteristics" (MPEP § 806.04(f)) and the "relationship" (MPEP § 808.01(a)) of the alleged species have not been provided to Applicants. A valid reason why the alleged species are not so linked as to form a single general inventive concept is absent in the Action.

In accordance with MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The "general test" as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which are found in a first species but not in a second species, while a second claim recites limitations only for the second species and not the first species. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

The Action has not indicated which claim recites limitations which are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first, as is required in order to meet the noted "general test" of MPEP § 806.04(f). Thus, the Action procedurally fails to present a valid reason for the requirement.

Where does the Action demonstrate that the alleged species are mutually exclusive (MPEP § 806.04(f))? For example, where does the Action show that the alleged species are prevented from being used in the same embodiment? It doesn't. Where does the Action provide evidence that the other alleged species are specifically prevented from be used with alleged Species VIII? It doesn't. Where does the Action provide a reason why the alleged Species VIII and each of the other alleged Species are mutually exclusive species? It doesn't. Likewise, the Action does not provide valid reasons of mutual exclusivity for the other alleged species. The Action has not shown that each alleged specie cannot be used in an embodiment with another alleged specie. Rather, the Action's own allegations appear to be contrary to the general test for species being mutually exclusive.

Nor has the Office demonstrated where the alleged species actually occur in the claims or the common characteristic linking each of the alleged species. Applicants respectively disagree with the Actions' allegations and descriptions of species. For these reasons it is respectfully submitted that there is no valid basis for requiring species election. Thus, it is respectfully submitted that the requirement should be withdrawn.

The Requirement is not legally proper because it is incomplete/unclear

The Action does not meet the requirements for species restriction. The Action does not clearly identify each of the alleged species to which claims are restricted. The Action merely alleges that different sets of claims are not so linked as to form a single general inventive concept. The Action leaves Applicants the burden of properly responding to an unclear and improper requirement. Because the criteria for a proper species restriction requirement has not been met by the Office, Applicants have not been given a fair opportunity to make an informed election. On this basis it is respectfully submitted that the requirement should be withdrawn.

The Action does not present a valid species restriction requirement based on the laws, rules, and Patent Office procedures. The Action at best pertains to allegations of species. There is no proper species election requirement to be made. For these reasons it is respectfully submitted that the requirement is improper. As there is no valid basis for requiring the species election requirement, it is respectfully submitted that the requirement should be withdrawn.

Applicants, as the requirement is best understood, have provisionally elected with traverse the alleged Species VIII. However, Applicants reserve all rights to change or modify their election based on the alleged species election requirement presentation being made a legally proper requirement.

Rejoinder

The Action also has not addressed the issue of rejoinder of claims (MPEP § 1893.03(d) and § 821.04). Applicants respectfully submit that even if the claims were somehow directed to different species as alleged, that claims would still be entitled to rejoinder. Applicants reserve all rights to rejoinder.

Conclusion

The species election requirement is respectfully traversed. The species election requirement is not proper. Therefore, it is respectfully requested that the species election requirement be withdrawn.

The undersigned is willing to discuss any aspect of the Application by phone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000